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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/831,516	06/25/2001	Viktor Mikhailovich Drobosyuk	56957-040(PVIK-3)	5891
7590 05/12/2004			EXAMINER	
Scott A Ouellette McDermott Will & Emery 28 State Street Boston, MA 02109-1775			ALVO, MARC S	
			ART UNIT	PAPER NUMBER
			1731	

DATE MAILED: 05/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/831,516

Applicant(s)

DROBOSYUK

Examiner

Steve Alvo

Art Unit

1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 6-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

The restriction requirement was made Final in the last Office Action.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 85/03962 in view of DUNNING et al (3,349,035) or APPEL (4,375,458).

WO 85/03962 teaches a method of making tissue paper by preparing a fibrous suspension (2), transferring the layer of fibers (12) to a profiling belt (16) and pressing the profiling belt (16) between embossing rolls (18 and 20). APPEL or DUNNING et al teach moistening the belt during pressing to ensure proper moisture content of the web. It would have been obvious to the artisan to provide the water sprays of APPEL (131) or (135) or DUNNING et al (unlabeled nozzles and 174 of Figure 12 or nozzles Fig. 5) during the pressing and bonding WO 85/03962 to ensure the web is at the proper moisture content for embossing and bonding. WO 85/03962 teaches that the embossing rollers could be smooth rolls and web 16 could do the embossing instead (page 4, lines 8-13).

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-5 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in

the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The specification is non-enabling with how the moistening belt can have a lower sorption capacity than the impressed areas fibrous layer and higher than the areas that are not impressed. The specification indicates that "water is squeezed out from the compacted sections into the non-compacted sections, due to the difference in capillary absorption pressures" (specification, page 6, lines 14-16). This would indicate that the non-compacted sections have a greater sorption capacity than the compacted section, since the capillary pressure would flow to the section having greater sorption capacity. How can the belt have a lower sorption capacity than the impressed areas and higher than the areas that are not impressed, if the areas that are not impressed have a higher sorption capacity than the impressed areas?

Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

How can the belt have a lower sorption capacity than the impressed areas and higher than the areas that are not impressed, if the areas that are not impressed have a higher sorption capacity than the impressed areas? See specification, page 6, lines 14-16. An explanation is required.

Applicants' arguments have been considered, but are not convincing as the use of a moistening belt during compression of the fibrous layer is taught by DUNNING et al (3,349,035) or APPEL (4,375,458). The application of moisture claimed does not appear to differ from the application of moisture as applied by APPEL or DUNNING et al, especially Figure 12 of

DUNNING et al. The moistened belt of DUNNING et al (3,349,035) or APPEL (4,375,458) would function in the same manner as the instant belt under the areas of compression. The step of moistening the first areas of the layer of fibers can be obvious even if done for a different purpose, In re Heck, 216 USPQ 1038, In re Kronig, 190 USPQ 425, In re Gershon, 152 USPQ 602. The mere recitation of a newly discovered function, reasonably considered possessed by the prior art process, does not cause claims drawn thereto to distinguish over the prior art. In re Best, 195 USPQ 430. It is well settled that it is not necessary for a finding of obviousness under 35 U.S.C. 103 that the prior art teaches or suggests practicing a claimed invention for the purpose described by applicant. In re Kemps, 40 USPQ2d 1309, In re Dillon, 16 USPQ2d 1897.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

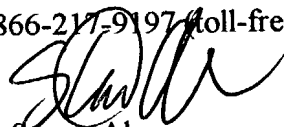
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Alvo whose telephone number is 571-272-1185. The examiner can normally be reached on 5:45 AM - 2:15 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Steve Alvo
Primary Examiner
Art Unit 1731

msa